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10/751,362

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EXAMINER

CHAPMAN, GINGER T

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/751,362	Applicant(s) NAIR ET AL.	
	Examiner Ginger T. Chapman	Art Unit 3761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 February 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,9,11,22-30 and 32 is/are pending in the application.
- 4a) Of the above claim(s) 25-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,9,11,22-24,30 and 32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>02/18/2009</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of the claims

1. Claims 2-8, 10, 12-21 and 31 are cancelled; claims 1, 9, 11, 22-30 and 32 are pending in the application; claims 25-29 are withdrawn from consideration as being drawn to nonelected inventions, claims 1, 9, 22-24, 30 and 32 are examined on the merits.

Response to Arguments

2. Applicant's arguments filed February 18, 2009 have been fully considered but they are not persuasive.

3. Applicant argues the following:

4. (I) A *prima facie* case of obviousness has not been established because the combination of Pargass and Yeo do not teach or suggest all the claim limitations recited in newly amended independent claims 1 and 30, in particular the claims have been amended to include the limitations that the absorbent articles are stacked in the package in a randomly selected order. Applicant submits that the cited combination of Pargass and Yeo do not teach or suggest the claimed limitation that the articles are stacked in the package in a randomly selected order.

5. (II) With regard to this limitation, Applicant submits that the Office action asserts that a patentable distinction does not exist between the prior art and the instant claimed invention because the differences are non-functional printed matter, Applicant believes that the Office action does not address the claim limitations of the articles stacked in randomly selected order in light of the teachings of Pargass and Yeo.

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6. (III) Applicant believes that Pargass teaches away from the claimed randomly selected order because Pargass teaches articles with distinct repeating graphics in packages.

7. These arguments are not persuasive for the following reasons:

8. As an initial matter, the differences among the non-functional printed matter relate to the printed graphics on the diapers having a predetermined association wherein the predetermined association includes a common theme. This is a separate limitation from the limitation that the articles are stacked in the package in a randomly selected order.

9. (I) The limitation that the articles are stacked in a particular order is a matter of intended use. In apparatus, article and composition claims, intended use must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. See MPEP § 2111.02. The intended use may further limit the claim if it does more than merely state purpose or intended use.

10. Here, the intended use of the diaper articles is to provide them to a consumer by placing them in a package in an order selected or chosen by the seller of the articles. Therefore Applicants' arguments do not pertain to what is claimed, a product; these arguments pertain to the patentability of methods or processes of distributing and marketing products by packaging articles in a manner that is attractive to a consumer. The order in which the diaper articles are placed in the package is not a structural limitation of the product.

11. For example, the diapers in the package can be taken out of the package and rearranged in an entirely different non-random or random order then replaced into the package; each diaper can also be provided in a single package. The structural elements of the diapers do not change because their order in the package is changed thus the order in which the diapers are placed in

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the package is irrelevant to the diaper structure. If products were patented based on intended use such as placing them in different orders, multiple patents could issue indefinitely for the same article merely by rearranging them in their packages.

12. Additionally, the decision of how to package the diapers in randomly selected orders or non-randomly selected orders is the result of a mental process, i.e. selecting how to distribute and sell the diapers is a marketing strategy of offering for sale products packaged in a manner which makes the purchase thereof attractive to a consumer

13. As noted, if products were patented based on simply changing the order in which they are packaged, multiple patents could issue indefinitely for the same product merely by placing them in a package in a different order.

14. (II) With respect to the non-functional printed matter, these arguments are answered in the rejection below, see paragraphs 27-28.

15. (III) With respect to Pargass teaching away from randomly selected packaging because Pargass teaches articles with repeating graphics in the packages, the disclosure by the reference of preferred embodiments does not teach away from the entire disclosure of a patent, all of which must be considered in the analysis of obviousness. *In re Burckel*, 201 USPQ 67, 70.

16. Pargass expressly teaches packaging sets of diapers to include any desired number of articles containing graphics (c. 15, l. 67 to c. 16, l. 2). Pargass remains silent on the order in which the diapers are placed in the package; however, the order in which the diapers are placed in the package is a mental selection process of how to package them and the articles of Pargass are fully capable of being placed in a package in a randomly selected order..

Claim Rejections - 35 USC § 103

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

19. Claims 1, 9, 11, 22-24, 30 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pargass et al (US 6,558,499) in view of Yeo (US 5,503,076).

20. With respect to claims 1 and 30, Pargass et al disclose an absorbent product (10) comprising a package and at least n absorbent articles contained in the package, wherein n is greater than 10 (column 5, lines 3-5), each of the absorbent articles having a body contacting surface (14) and a garment contacting surface (22) opposing the body contacting surface, each of the absorbent articles comprising: a component material (26) (c. 7, l. 54; fig. 3; c. 8, l. 27) disposed between the body contacting surface (14) and a garment contacting surface (22), the component material (26) having a printed graphic (21, 21') printed directly on the garment contacting surface comprising the outer layer of the backsheet (figs. 1 and 2); wherein the printed

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graphic (21, 21') of each of the n absorbent articles is different from the graphic of each of the remaining absorbent articles (c. 15, ll. 44-52 and c. 15, ll. 60 to c. 16, ll. 1-2) and all of the printed graphics (21, 21') of the n absorbent articles have a predetermined association (c. 10, ll. 17-21; see also c. 6, ll. 59; c. 7, ll. 12-15; c. 10, ll. 36-37). See also c. 2, ll. 9-13, disclosing that printed graphics having a predetermined association are known in the diaper art.

21. Pargass discloses the claimed invention except for the predetermined association includes a common theme and the articles are stacked in the package in a randomly selected order. The limitation of a "predetermined association includes a common theme" is not a structural limitation of the article and therefore does not serve to further limit the article.

22. The dictionary definition of "predetermined" is "to decide something at an earlier time" (Cambridge International Dictionary of English). The dictionary definition of "association" is, *inter alia*: something linked in memory or imagination with a thing or person; the process of forming mental connections or bonds between sensations, ideas, or memories (Merriam-Webster Online Dictionary). The dictionary definition of "theme" is "a subject or topic of discourse or of artistic representation; a specific and distinctive quality, characteristic or concern (Merriam-Webster Online Dictionary). Therefore the limitation of a predetermined association including a common theme is not a structural limitation of the article but rather is drawn to a mental process and therefore does not lend additional patentable weight.

23. Pargass discloses the claimed invention except for the articles are stacked in the package in a randomly selected order. The order in which the diaper articles are placed in the package is not a structural limitation of the product but is a matter of intended use. In apparatus, article and composition claims, intended use must result in a structural difference between the claimed

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invention and the prior art in order to patentably distinguish the claimed invention from the prior art. See MPEP § 2111.02. The intended use may further limit the claim if it does more than merely state purpose or intended use.

24. The decision of how to package the diapers in randomly selected orders or non-randomly selected orders is the result of a mental process, i.e. selecting how to distribute and sell the diapers is a marketing strategy of offering for sale products packaged in a manner which makes the purchase thereof attractive to a consumer. For example, the diapers in the package can be taken out of the package and rearranged in an entirely different non-random or random order then replaced into the package; each diaper can also be provided in a single package. The structural elements of the diapers do not change because their order in the package is changed thus the order in which the diapers are placed in the package is irrelevant to the diaper structure. Therefore this limitation does not lend additional patentable weight.

25. If products were patented based on simply changing the order in which they are placed in a package, multiple patents could issue indefinitely for the same product merely by placing them in a package in a different order.

26. Finally, the articles or Pargass are fully capable of being placed in a package in a randomly selected order.

27. Pargass discloses the claimed invention except for the backsheet of each of the articles comprises a microporous film material wherein the graphic is printed directly on the garment facing surface of the film and the backsheet further comprises a nonwoven material joined with the garment facing surface of the film and the graphic is visible through the film. As best depicted in Figures 2 and 3, Yeo teaches a diaper (c. 7, ll. 54-55) having a backsheet 10

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comprising a microporous film 14 (c. 5, l. 51) with graphics printed directly on the film (c. 8, ll. 44-48) and the backsheet 10 further comprises a nonwoven material 12 joined with the film and the graphic is visible through the nonwoven (c. 4, ll. 22-24). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to form the backsheet of Pargass as taught by Yeo since Yeo states, at c. 8, ll. 45-47 and at c. 4, ll. 26-27, that the advantage of forming the article with this design is that the microporous film provides a smooth surface to support multi-colored printed graphics and the nonwoven protects the graphic from abrasion and provides a more cloth-like look and feel to the outer surface of the diaper.

28. With respect to claim 9, reciting the themes include cartoon characters and other various themes, this limitation is drawn to the content of the printed matter graphics. With respect to printed matter, the critical question is whether any new and unobvious relationship functional relationship exists between the printed graphic and the substrate, as per MPEP § 2112.01, III. Here, both the instant and the prior art graphics are printed on microporous film with nonwoven material comprising the outer cover of the article and the printed graphic is visible through the nonwoven. Outer covers are known in the art to comprise laminates of films and nonwovens in multiple layers, and therefore the claimed graphics do not define any new and unobvious functional relationship between the printed matter and the substrate. Therefore the prior art anticipates the claimed limitation in accordance with § MPEP 2112.01, III, as reproduced *infra*.

III. PRODUCT CLAIMS – NONFUNCTIONAL PRINTED MATTER DOES NOT DISTINGUISH CLAIMED PRODUCT FROM OTHERWISE IDENTICAL PRIOR ART PRODUCT

Where the only difference between a prior art product and a claimed product is printed matter that is not functionally related to the product, the content of the printed matter

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will not distinguish the claimed product from the prior art. *In re Ngai*, **>367 F.3d 1336, 1339, 70 USPQ2d 1862, 1864 (Fed. Cir. 2004)< (Claim at issue was a kit requiring instructions and a buffer agent. The Federal Circuit held that the claim was anticipated by a prior art reference that taught a kit that included instructions and a buffer agent, even though the content of the instructions differed.). See also *In re Gulack*, 703 F.2d 1381, 1385-86, 217 USPQ 401, 404 (Fed. Cir. 1983)("Where the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability [T]he critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate."). MPEP § 2112.01, III.

29. It is well known in the packaging art to provide packaging elements with ornamental graphical and product information to induce potential consumer interest. Therefore the selection of graphics would have been within the level of ordinary skill and obvious for the reason of providing advertisement, identification or information about the product or ornamental graphics to induce consumer interest in the article. Additionally, the content of the graphics is purely a matter of choice, when there is a variety of possible graphics, it means the designer can choose whatever graphics he desires. Therefore the theme, i.e. content of the graphics does not lend additional patentable weight because if articles were patented based on differences in graphics, multiple patents could issue indefinitely for the same article by simply changing the content of the graphic.

30. With respect to claim 11, Pargass et al disclose n is selected from 11 to 120 (c. 5, ll. 4-5)

31. With respect to claims 22 and 32, Pargass discloses the claimed invention except for inkjet printed graphics. Yeo teaches inkjet graphics (c. 9, ll. 7-9). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to print the

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graphics of Pargass by inkjet printing as taught by Yeo since Yeo states, at c. 8, ll. 66-67 and c. 9, ll. 5-10, that the advantage of using inkjet printing is that the process can handle multi-color printing with no fouling of equipment.

32. With respect to claims 23 and 24, Pargass discloses the claimed invention except for the sheet of material extending from the first to second waist region is microporous film and the graphic is printed directly on the garment facing surface of the film as recited in claim 23, and a nonwoven material joined with the garment facing surface of the film and the printed graphic is visible through the material. As best depicted in Figures 2 and 3, Yeo teaches microporous film 14 and the graphics (fig. 3) printed directly thereon, a nonwoven material 12 joined thereto and the graphic is visible through the material 12 (c. 4, ll. 20-30). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to form the article of Pargass as taught by Yeo since Yeo states, at c. 4, ll. 21-30, that the advantage of forming the article with this design is that it provides colorful graphics which are visually appealing; the microporous film provides a smooth surface to support multi-colored printed graphics and the nonwoven protects the graphic from abrasion and provides a more cloth-like look and feel to the outer surface of the diaper.

Conclusion

33. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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34. Stavrulov (WO 00/13632) teaches graphics in the form of texts and pictures of educational, entertaining, instructive or other nature attractive to a consumer thereby increasing consumer demand for the product.

35. Reed et al (WO 99/60973) and (WO 99/32164): teaches graphics printed on backsheets of diapers wherein the backsheets comprise microporous film material wherein the graphic is printed directly on the garment facing surface of the film and the backsheet further comprises a nonwoven material joined with the garment facing surface of the film and the graphic is visible through the film.

36. Schleinz et al (US 5,458,590) teaches graphics printed on backsheets of diapers wherein the backsheets comprise microporous film material wherein the graphic is printed directly on the garment facing surface of the film and the backsheet further comprises a nonwoven material joined with the garment facing surface of the film and the graphic is visible through the film.

37. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ginger T. Chapman whose telephone number is (571)272-4934. The examiner can normally be reached on Monday through Friday 9:30 a.m. to 6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tatyana Zalukaeva can be reached on (571) 272-1115. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ginger T Chapman/
Examiner, Art Unit 3761
05/18/09

/Tatyana Zalukaeva/
Supervisory Patent Examiner, Art Unit 3761